

REMARKS

Claim 1, as amended, and claims 2-4, 15-17, and 19-21 are pending in the instant application. No new matter has been added as a result of the above-described amendments. The objections and rejections set forth in the Office Action have been overcome by amendment.

1. Objection to the specification

The Office Action contains an objection to the specification because the first line of the specification should be updated to reflect that U.S. Application No. 09/284,100 has issued as U.S. Patent No. 6,743,422.

Applicants have amended the specification to indicate that U.S. Application No. 09/284,100 issued as U.S. Patent No. 6,743,422 on June 1, 2004, and therefore, respectfully request that this objection be withdrawn.

2. Objection to the drawings

The Office Action contains an objection to the drawings because tables and sequences included in the specification must not be duplicated in the drawings. In support of this objection, the Action cites 37 C.F.R. §§ 1.58(a) and 1.83. The Action suggests that Applicants should amend the specification to delete any Figures which consist only of nucleic acid or protein sequences which have been submitted in their entirety in computer-readable format (*i.e.*, as SEQ ID NO's), and should further amend the specification accordingly to reflect the replacement of the Figure by the appropriate sequence identifier.

Applicants respectfully disagree with the Action's assertion that the figures in the instant application do not comply with 37 C.F.R. §§ 1.58(a) and 1.83. Applicants note that § 1.58(a) states:

The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables may only be included in both the drawings and description portion of the specification if the application was filed under 35 U.S.C. 371. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

37 C.F.R. § 1.58(a). This section does not prohibit drawings from containing nucleic acid or amino acid sequences, regardless of whether such sequences appear in the sequence listing, but rather,

states that the specification "shall not contain drawings or flow diagrams." Applicants also note that § 1.83(a) states:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables and *sequence listings* that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

37 C.F.R. § 1.83(a) (emphasis added). Again, this section does not prohibit drawings from containing nucleic acid or amino acid sequences, but rather, states that "sequence *listings* that are included in the specification are . . . not permitted to be included in the drawings." *Id.* (emphasis added). Section 1.821(c) defines a "sequence listing" as "a paper or compact disc copy . . . disclosing the nucleotide and/or amino acid sequences [disclosed in a patent application] *and associated information* using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823." 37 C.F.R. § 1.821(c) (emphasis added). Figures 1-4 of the instant application contain nucleic acid and amino acid sequences, and not sequence listings. In fact, while the amino acid sequences depicted in Figures 2-4 are set forth using single-letter abbreviations, amino acid sequences in a sequence listing must be listed using three-letter abbreviations. 37 C.F.R. § 1.822(d)(1). Because the figures of the instant application do not contain sequence listings, Applicants contend that the figures comply with 37 C.F.R. §§ 1.58(a) and 1.83, and therefore, respectfully request that this objection be withdrawn.

3. Objection to the claims

The Office Action contains an objection to claim 1 as reciting non-elected inventions.

Applicants have amended claim 1 so that it no longer recites non-elected species, and therefore, respectfully request that this objection be withdrawn.

4. Rejection of claims 1-4, 15-17, and 19-21 under 35 U.S.C. § 102

The Office Action asserts a rejection of claims 1-4, 15-17, and 19-21 under 35 U.S.C. § 102(a), as being anticipated by U.S. Patent No. 6,077,692 (the '692 patent). The Action states that

the '692 patent discloses a KGF-2 polypeptide consisting of residues 65-208 of the KGF-2 protein which has 100% sequence identity to the KGF-2 fragment claimed in the instant application.

Applicants note that according to the USPTO Public PAIR website: (1) the '692 patent issued from U.S. Application No. 09/023,082 (the '082 application), which was filed on February 13, 1998, and which claims priority from Provisional Application No. 60/055,561 (the '561 application), which was filed on August 13, 1997; (2) the '561 application is a continuation-in-part of U.S. Application No. 08/910,875 (the '875 application), which was filed on August 13, 1997; (3) the '875 application is a continuation-in-part of U.S. Application No. 08/862,432 (the '432 application), which was filed on June 23, 1997; (4) the '432 application claims the benefit of U.S. Provisional Application Nos. 60/039,045 (the '045 application), which was filed on February 13, 1996, and 60/023,852 (the '852 application), which was filed on August 13, 1996; and (5) the '432 application is a divisional of U.S. Application No. 08/461,195 (the '195 application), which was filed on June 7, 1995. Applicants also note that while the Examiner provided a copy of the '692 patent with the instant Action, Applicants have not had access to the '045, '852, or '195 applications, upon which instant rejection depends. Applicants contend that as between the U.S. Patent Office and Applicants, the U.S. Patent Office is in the best position to demonstrate that the subject matter which forms the basis of the instant rejection, and which is disclosed in the instant application, is (if it is) also disclosed in the '045, '852, or '195 applications. Pursuant to 37 C.F.R. § 104(d)(2), Applicants request that the Examiner make a determination as to whether a KGF-2 polypeptide consisting of residues 65-208 of the KGF-2 protein is disclosed in the '045, '852, or '195 applications. Applicants contend that in absence of such a determination, the '692 patent is only entitled to the filing date of the '082 application (*i.e.*, February 13, 1998), and, therefore, that this reference is not in the prior art to the instant application under 35 U.S.C. § 102. Applicants, therefore, respectfully request that this ground of rejection be withdrawn.

CONCLUSIONS

Applicants respectfully contend that all conditions of patentability are met in the pending claims as amended. Allowance of the claims is thereby respectfully solicited.

If Examiner Xie believes it to be helpful, the Examiner is invited to contact the undersigned representative by telephone at 312-913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

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